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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/936,457	03/12/2002	Ian James Whitworth	2308/250	4123
7590	10/18/2004		EXAMINER	
Michael L Goldman Nixon Peabody Clinton Square PO Box 31051 Rochester, NY 14603			ROSSI, JESSICA	
			ART UNIT	PAPER NUMBER
			1733	

DATE MAILED: 10/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/936,457	WHITWORTH, IAN JAMES
	Examiner	Art Unit
	Jessica L. Rossi	1733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
 THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 7/1/04, Amendment.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-11 and 26-36 is/are pending in the application.
 - 4a) Of the above claim(s) 26-36 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-11 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Response to Amendment

1. This action is in response to the amendment dated 7/1/04. Claims 12-25 were cancelled. Claims 26-36 were added. Claims 1-11 and 26-36 are pending.
2. Support for the limitations set forth in claim 3 can be found on p. 3, line 20 – p. 4, line 10; p. 6, line 19 – p. 7, line 10, and Figures 1 and 4.
3. Support for the limitations set forth in claim 11 can be found on p. 5, lines 4-11.

Election/Restrictions

4. Newly submitted claims 26-36 are directed to an invention that is not so linked to the invention originally claimed so as to form a single general inventive concept under PCT Rule 13.1 for the following reasons:

The technical feature shared by the original claims (1-11) and new claims (26-36) is all the limitations set forth in steps a) through c) of claim 1. This common technical feature does not distinguish the claimed invention over the prior art, as shown by the teachings of Mossbeck et al. (US 6143122; see 102 rejection of claim 1 set forth in paragraph 9 of the previous office action dated 1/29/04). Therefore, the original and new claims do not relate to a single general inventive concept because they do not share a special technical feature that defines a contribution over the prior art. Accordingly, unity of invention between the original and new claims is lacking and restriction is proper.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution

on the merits. Accordingly, claims 26-36 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

37 C.F.R. 1.131 Declaration

5. The declaration filed on 7/1/04 under 37 CFR 1.131 has been considered but is ineffective to overcome the Mossbeck et al. reference (US 6143122).
6. The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Mossbeck et al. '122 reference (September 15, 1998). While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897).

In paragraphs 4-5 of the declaration, Applicant relies on Exhibit 3 to establish conception prior to the filing date of the Mossbeck et al. '122 reference (9/15/98). The MPEP defines conception as "a disclosure of an invention which enables one skilled in the art to reduce the invention to a practical form without exercise of the inventive faculty" (MPEP 2138.04). Based on the schematic provided in Exhibit 3, the skilled artisan would not be enabled to reduce the invention to practical form so as to perform Applicant's claimed method steps without exercising inventive faculty; therefore, the evidence submitted is insufficient to establish conception prior to 9/15/98.

7. The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Mossbeck et al. '122 reference (9/15/98) to either a constructive reduction to practice or an actual reduction to practice (MPEP 2138.06).

In part (1) of paragraph 7 of the declaration, Applicant relies on the meeting discussed in paragraph 5 of the declaration to establish due diligence **prior** to 9/15/98. To establish due diligence, unlike when establishing conception, Applicant must provide **actual dates** of acts relied on to establish due diligence and cannot merely allege that acts referred to occurred prior to a specified date (MPEP 715.07, p. 700-250, “establishment of dates”). Applicant merely alleges that the meeting took place before 9/15/98, which is insufficient to establish diligence prior to 9/15/98.

In parts (1)-(3) of paragraph 7 of the declaration, Applicant relies on a second meeting and the filing dates of the UK Patent Application and the PCT Patent Application to establish diligence during a time period somewhere between 9/15/98 and filing of the present application. As for the second meeting, which is discussed in paragraph 6 and Exhibits 4-5 of the declaration, Applicant has failed to provide actual dates for this meeting and therefore such is insufficient to establish diligence at a point in time somewhere between 9/15/98 and filing of the present application. The UK Application was filed on 3/17/99 and the PCT Application was filed on 3/13/00, as set forth in paragraphs 2-3 and Exhibit 2 of the declaration, wherein the filing of these applications is sufficient to establish diligence at those specific points in time.

In part (4) of paragraph 7 of the declaration, Applicant states that the present application (09/936,457) was filed on 9/13/01. The examiner points out that this is incorrect since the application was actually filed on 3/12/02, as set forth in paragraph 3 and Exhibit 1 of the declaration.

Therefore, Applicant has failed to establish due diligence since the totality of the evidence provided in parts (1)-(4) does not account for the **entire period** during which due

diligence is required – the “critical period” for diligence beginning **prior** to the date of reduction to practice of the Mossbeck et al. reference (9/15/98) and **continuing** until Applicant’s constructive or actual reduction to practice (MPEP 2138.06, p. 2100-117).

Claim Rejections - 35 USC § 102

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
9. Claims 1-2, 5, and 9 stand rejected under 35 U.S.C. 102(e) as being anticipated by Mossbeck et al. (US 6143122; of record), as set forth in paragraph 9 of the previous office action dated 1/29/04.

Claim Rejections - 35 USC § 103

10. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
11. Claim 6 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Mossbeck et al. as applied to claim 1 above and further in view of Eto (US 5792309; of record) and St. Clair (WO 96/07345; of record), as set forth in paragraph 11 of the previous office action.
12. Claim 7 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Mossbeck et al. as applied to claim 1 above and further in view of Suenens et al. (US 5016305; of record), as set forth in paragraph 12 of the previous office action.
13. Claims 1-5 and 7-11 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Suenens et al. in view of Mossbeck et al., as set forth in paragraph 13 of the previous office action.

Regarding claim 3, Suenens teaches the first string being positioned into juxtaposition with the adhesive applicators by being fed longitudinally along (Figure 6), and then displaced transversely from (Figure 7), an axis parallel to the longitudinal axis of the first string; note “longitudinal axis” of the string is taken as the length of string.

Regarding claim 11, Suenens teaches the adhesive being dispensed from the applicators while movement of the first string relative to the applicators is taking place (column 4, lines 60-64).

14. Claim 6 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Suenens et al. and Mossbeck et al. as applied to claim 1 above, and further in view of the collective teachings of Eto, Suenens et al. (EP 421495; of record), and Mossbeck (US 6159319; of record), as set forth in paragraph 14 of the previous office action.

Response to Arguments

15. Applicant's arguments filed 7/1/04 have been fully considered but they are not persuasive. It is noted Applicant's only arguments pertain to the 1.131 Declaration where Applicant asserts that conception and due diligence have been established and therefore the Mossbeck et al. '122 reference no longer applies as prior art against the claims of the present invention.

The Examiner directs Applicant to paragraphs 5-7 above where reasons for the 1.131 Declaration being ineffective to overcome the Mossbeck et al. '122 reference were clearly set forth, and hence Applicant's arguments were fully addressed therein.

Conclusion

16. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

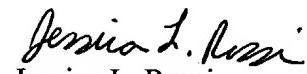
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Jessica L. Rossi** whose telephone number is **571-272-1223**. The examiner can normally be reached on M-F (8:00-5:30) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Blaine R. Copenheaver can be reached on 571-272-1156. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1733

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jessica L. Rossi

Patent Examiner

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